



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,100	04/10/2006	Michael Grass	288804US0X PCT	3709
22850	7590	08/27/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER GALE, KELLETTE	
			ART UNIT	PAPER NUMBER
			1621	
			NOTIFICATION DATE	DELIVERY MODE
			08/27/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/575,100	Applicant(s) GRASS ET AL.	
	Examiner Kellette Gale	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>April 10, 2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 15 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22 and 23, and 1, and 1 of copending Application Nos. 11/739,345, 10/418,103, and 10/570,199 respectively.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

1. A composition comprising benzoic esters and isononyl benzoate and a composition comprising at least one alkyl ester of benzoic acid wherein the alkyl group of the alkyl ester has from 7 to 13 carbon atoms are obvious variants of each other.
2. A composition comprising benzoic esters and isononyl benzoate is open ended, therefore, it does not exclude other components. With that said, a mixture

Art Unit: 1621

comprising isomeric isononyl benzoates wherein an isononyl alcohol mixture obtained by saponifying the isomeric isononyl benzoates comprises a mixture of isomeric isononyl alcohols other than 3,5,5-trimethylhexanol is an obvious variant of a composition comprising benzoic esters and isononyl benzoate.

3. A composition comprising an aqueous dispersion of at least one film-forming polymer selected from homopolymers and copolymers, including terpolymers, and at least one film-forming agent, wherein said composition comprises, as at least one film-forming agent, isononyl benzoate is an obvious variant of a composition comprising benzoic esters and isononyl benzoate. The phrase, "at least one", implies that there could be more than one which could, in turn, be a benzoic ester.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 1621

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McConnell et al (USP 6,235,924 B1) in view of applicant's admission.

Applicant claims a composition comprising benzoic esters and isononyl benzoate having a tin content below 1mg/kg and being used in paints varnishes, adhesives or components of adhesives or as a viscosity reducer and/or plasticizer for PVC.

Determination of the scope and content of the prior art

(MPEP §2141.01)

McConnell et al teaches a process for preparing benzoic acid esters which results in a composition of one or more benzoic acid esters. These benzoic acid esters are made from the corresponding monohydric alcohols having from 6 to 12 carbon atoms. Therefore, if a monohydric alcohol having 9 carbon atoms were to be used to prepare a benzoic acid ester, then the resulting isononyl benzoate will be present along with any other isomer of the benzoic acid ester. The tin content is not mentioned therefore, it is presumed by the Examiner to not be present.

Applicant has admitted in the background of the specification that benzoic acid esters may be used as plasticizers among other things.

Ascertainment of the difference between the prior art and the claims

(MPEP §2141.02)

The difference between the prior art and the claims is that McConnell et al does not teach in the examples the preparation of isononyl benzoate composition. However, 2-ethylhexyl benzoate is taught from the reaction of benzoic acid and 2-ethylhexanol.

Art Unit: 1621

Therefore, if isononyl alcohol were to be reacted with benzoic acid the corresponding isononyl alcohol composition would be prepared having a content of other benzoic esters.

Finding of prima facie obviousness

Rational and Motivation (MPEP §2142-2143)

Since it is shown in McConnell et al that the reaction of benzoic acid with 2-ethylhexanol results in the composition comprising 2-ethylisohexyl benzoate and 2-ethylbenzoate, it would be obvious for one of ordinary skill in the art at the time of the instant invention to use the structurally similar isononyl alcohol to prepare an isononyl benzoate composition using the reaction scheme of the prior art. One of ordinary skill in the art at the time of the instant invention would be motivated to utilize such a reaction to prepare an isononyl benzoate composition since it is well known in the art to use such a composition as plasticizer among other things.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kellette Gale whose telephone number is (571) 272-8038. The examiner can normally be reached on M-F (6:30am-3:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, YVONNE EYLER can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kellette Gale
Patent Examiner
Technology Center 1600
August 16, 2007



Samuel Barts
Primary Patent Examiner
Technology Center 1600